

Application Serial No. 09/740,051

Response After Final Action of June 2, 2005

### Remarks

Claims 1-24 stand rejected and are under final rejection. Applicant respectfully requests that Examiner consider the remarks contained herein. Applicant traverses all the rejections and believes they are improper as discussed below. Furthermore, Applicant respectfully submits that the latest Office Action should not have been made final because the rejections are improper and requests withdrawal of the finality of the action.

#### **Improper Reliance on the Suliman publication reference**

The Examiner continues to rely and base all the rejections on the Suliman patent application publication, #20010053980. In Applicant's response to Office Action of Aug 24, 2004, Applicant has pointed out that the Suliman publication, #20010053980, may be relied on as a prior art reference only to the extent that the subject matter in the reference has proper support in the priority document, and that much of the disclosure relied on by Examiner to support the prior rejections are not supported by the priority document, and therefore those rejections should be withdrawn.

Examiner disagree with applicant, asserting that he is entitled to use the entirety of the Suliman publication as prior art on which to base his rejections. Examiner quotes MPEP 2136.03 (iii) as pertinent to the question at hand:

"The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications ... entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions **if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.**"

Examiner then states that he has *"concluded that the disclosure, while not word for word original of the published utility application, teaches and suggests the principles that the Examiner relies on when making his rejections based on the published utility application"*. Examiner then goes on to assert that the examiner *"is entitled to use, not only the disclosure of the provisional application, Serial No. 60/172351, but also the entirety of the U.S. Patent Application #20010053980."*

Although Applicant agrees that the quoted MPEP section is pertinent to the issue at hand, Applicant disagrees with Examiner's conclusion and assertion. Applicant has pointed out in an

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earlier response, which applicant incorporates herein, and refers the Examiner to the text of that response, that the Suliman priority document is directed to a single invention of a blind warranty registration system, and that most of what Examiner has relied on to make his rejections are not supported, not even suggested, by the Suliman priority document, and therefore the rejections are improper (a more detailed discussion is provided below).

As mentioned, Applicant disagrees and takes issue with Examiners assertion that "the original of the published utility application, teaches and suggests the principles that the Examiner relies on when making his rejections based on the published utility application".

Respectfully, not only does the original application not teach or suggest the principles as the Examiner suggests, but this is not the test to be used under U.S. patent law. The test of whether the priority document properly supports the subject matter in the published application relied on to make the rejection is whether (as stated in MPEP 2136.03 (iii)):

**"the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph."**

Applicant respectfully reminds Examiner of the requirements of 35 U.S.C. 112, first paragraph

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

It is clear that most of the subject matter disclosed within the published application, relied on by Examiner in making of the rejections (the specific disclosures referenced are discussed below under the 102(e) rejections), are neither supported, taught or suggested by the priority document, and to be sure, do not meet the requirements set out in 35 U.S.C. 112, first paragraph, i.e., **the inventive concepts are not described, nor is the manner of making and using them described, in such full, clear, concise, and exact terms as to enable any person skilled in the art ... to make and use the same, nor is the best mode disclosed.** This is restated by the MPEP in 706.02(f)(1):

**"The subject matter used in the rejection must be disclosed in the earlier filed application in compliance with 35 USC 112, first paragraph, in order for that subject matter to be entitled to the earlier filing date under 35 USC 102(e)."**

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**Rejections under 35 USC 102(e)**

Specifically, and referring to Examiners latest rejections under 35 USC 102(e), Examiner rejects amended claims 1 and 12, which incorporate the limitation of "the electronic data file is in the possession of the entity", and claims 7 and 16 which specify that the "electronic data file is stored on a smart card" by referencing Page 4 Para 45 of Suliman:

a consumer can use a smart card device 50, such as a smart card enabled credit card, that is capable of storing and operating software that could capture product information at the point-of-purchase. The product information could be communicated directly from the point-of-purchase to the registration system 10 via a credit card network, through the credit card provider's bill processing system, or after download to another consumer device 50, such as the consumer's PC or WAP-enabled PDA or cell phone

The Examiner's reliance on this disclosure of the Suliman publication is improper for the reasons stated above. There is not suggestion or teaching anywhere in the Suliman priority document regarding smart cards or the like or even of a scenario where the electronic data file is in the possession of the entity or that the file is on a smart card, as discussed by Applicant in the previous amendment. Therefore, the above disclosure cannot be relied upon because the provisional application **does not** properly supports the subject matter relied upon to make the rejection **in compliance with 35 U.S.C. 112, first paragraph**. i.e., there is no description of the invention and manner of how to make and use it in such full, clear, concise, and exact terms...to enable any person skilled in the art ..., to make and use the same; neither is the requirement of setting out the best mode met by the priority document with respect to the disclosure relied upon by the Examiner. Indeed, such an invention or concept is not even hinted at by the priority document. Examiner also references Suliman Page 4 Para 41. This disclosure is also not supported by the Suliman priority document in compliance with 35 U.S.C. 112, first paragraph and cannot be relied upon in. Regarding the rejections under 35 USC 103, discussed further below, Examiner again references subject matter on which he is not entitled to rely, namely Para 63 in rejecting claim 9.

Applicant notes that most of the disclosure relied on by Examiner in both this and the previous office action are not supported by the priority document, to the extent required under 35 USC 112 1<sup>st</sup> paragraph, as discussed above. If Examiner believes differently then Applicant respectfully request Examiner to point out the support for each rejection the priority document and explain how such disclosure, in conformance with 35 USC 112 para 1, supports that disclosure of the publication relied on by the examiner.

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Specifically, the following rejections, under 35 USC 102(e) are improper and should be withdrawn because the specific Suliman disclosure relied on for each rejection, as noted by the Examiner in parentheses after each rejection, is not properly supported in the priority document.

**With regard to Claim 2**, Suliman teaches a media and method wherein: registration is performed during the purchase of the asset. (Para. 45 lines 4-7)

**With regard to Claims 5,14**, Suliman teaches a media and method wherein: the electronic file is installed on a media accessible to a third party's computer. (Para. 62 lines 1 1-1 6, Para. 66 lines 21 -26, Para. 77 lines 1-5)

**With regard to Claims 8,17**, Suliman teaches a media and method wherein: the data file includes data for insuring an asset. (Para. 51 lines 8-1 1, Para. 64 lines 7-1 1)

**With regard to Claim 10**, Suliman teaches a media and method wherein: the registration database provides a composite record of assets registered by specific entities and allows for the reporting and manipulation of the same. (Para. 52 lines 16, Para. 62 lines 3-4, Figure #8)

**With regard to Claim 19**, Suliman teaches the method wherein: said asset specific data is not manually provided by the entity and the entering of said data does not depend on the entity. directly providing said asset specific data. (Page 4 Para. 45)

**With regard to Claim 20**, Suliman teaches the method wherein: said asset data is obtained at the time of purchase of the asset. (Page 4 Para. 45)

**With regard to Claim 21**, Suliman teaches the method wherein: said data specific to an entity is extracted at the time of purchase of the asset. (Page 4 Para. 45)

**With regard to Claim 22**, Suliman teaches the method wherein: said data file is located on the entity's computer and at least a subset of said data specific to the entity is entered into the electronic data file by the entity. (Page 3 Para. 37)

**With regard to Claim 23**, Suliman teaches the method wherein: the entity is able to directly modify the entity specific data. This limitation is an inherent part of the process of a registry system. That is to say, once a file is kept with regard to either a purchaser or a product, the ability to change personal information is always part of the process.

**With regard to Claim 24**, Suliman teaches the method comprising:

....  
entering data specific to an asset into the registration database where in said asset specific data is not manually provided by the entity and the entering of said data does not depend on the entity directly providing said asset specific data;  
(Page 3 Para. 37)  
....

None of these referenced section of the Suliman publication, are supported by the priority document. As stated in Applicant's earlier response, Applicant has amended the claims in view of the prior art cited, and believes those claims to be allowable.

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**Rejections under 35 USC 103(a)**

Claims 3, 4, 6, 9, 13, and 15 stand rejected under 35 USC 103 in view of Suliman. In view of the above remarks and for the same reasons given above, these rejections should be withdrawn, because they depend directly or indirectly from claims 1 or 12 and the rejections of those claims have been overcome.

Nevertheless, with regard to claims 3, 4, and 13, the Examiner provides web cookies as an example of having a data file extracted remotely from a computer over the Internet. Respectfully, the mechanism of "cookies" has to do with identifying an individual computer on the Internet by various third parties. Each computer may have hundreds of cookies placed on it by various web sites when a computer browser requests web page from each respective site. The cookies allow that computer to be recognized by a web-site when the computer loads a web-page of an individual web-site. Although a cookie is a data file, it contains minimal information, and such information is specific and detailed enough to only identify a particular computer. How exactly would a cookie be adapted by one of ordinary skill in the art to function in the context of the present invention, that of registering assets? Respectfully, the Examiner's motivation to combine, that of "user friendliness", is not a sufficient motivation, and appears to rely on hindsight. From Examiner's reasoning, it appears that any novel feature which enhances use friendliness, will render an invention obvious. Surely this position is contrary to and inconsistent with the purpose of the patent system; i.e., concluding that because, after understanding the invention in hindsight, the invention is rendered obvious because it is practical and user friendly.

With respect to claims 6 and 15, Examiner's reasons that because credit card companies are interested in the spending patterns of their customers, it would be obvious to modify Suliman is again, respectfully improper application of hindsight. Examiner states that he can "*clearly envision why a financial company might want to keep abreast of goods purchased and registered by cardholders ...*". The fact that in hindsight, the Examiner may recognize the advantages of the present invention and how a credit card company could make use of such advantages are not sufficient grounds for rejecting the claims as obvious. Examiner states that "*enhancements to customer service*" is sufficient motivation to combine. Applicant disagrees. Firstly, credit card companies provides no such service of asset registration and thus cannot enhance a non-existent service. Examiner seems to be suggesting that the creation of a new service, e.g., asset registration, by a credit card company, is an enhancement to the overall service, and thus renders

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the invention obvious. This, respectfully is erroneous reasoning. All companies are constantly thinking of new products and services with which to acquire and retain customers. To suggest that each new service discovered is obvious does not follow and is improper.

With respect to claim 9, as already mentioned, Para 63 is not supported by the Suliman priority document and cannot be relied on in making the rejection. Nevertheless, Examiner's conclusion that because Suliman makes a generic statement about how other services may become available, without any specificity, and that therefore the applicant's invention of insuring assets at the time of registration is obvious is improper and too broad, and appears to rely on Examiner's hindsight. Additionally, the numerous advantages provided by the present invention and not provided by the reference prior art have been described in the previous amendment. Applicant believes that the application is in condition for allowance.

#### Conclusion

For all the reasons discussed above, Applicant believes that all rejections have been overcome and respectfully submits that the application is in condition for allowance and requests that the finality of the latest action be withdrawn and a timely Notice of Allowance be issued.

Respectfully submitted,

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